

REMARKS

I. Claim Rejections - 35 U.S.C. §112

Reconsideration is requested of the Examiner's rejection of Claim 33 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner believes the claimed invention included the non-claimed invention of a conduit.

Applicant has amended independent Claims 38 and 39 so that the combination being claimed as the invention includes three elements - "a coupling member," "a (or a pair of) conduit," and "a connecting member." In view of this amendment, Applicant believes this rejection is now moot.

II. Claim Rejections - §102 (Sullivan)

Reconsideration is requested of the Examiner's rejection of Claims 2-16, 18-35, and 37-40 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,846,169 to Sullivan. The Examiner continued to rely on the Sullivan reference for disclosing all the elements of independent Claims 38 and 39. The Examiner summarily rejected Applicant's previous arguments that the Sullivan reference failed to disclose all the elements of Claims 38 and 39 and is a distinctively different structure for a different purpose. The Examiner fails to point out the specific reference / citation in the Sullivan reference in again rejecting the claims. In addition, there has been no basis provided by the Examiner in rejecting Claim 39.

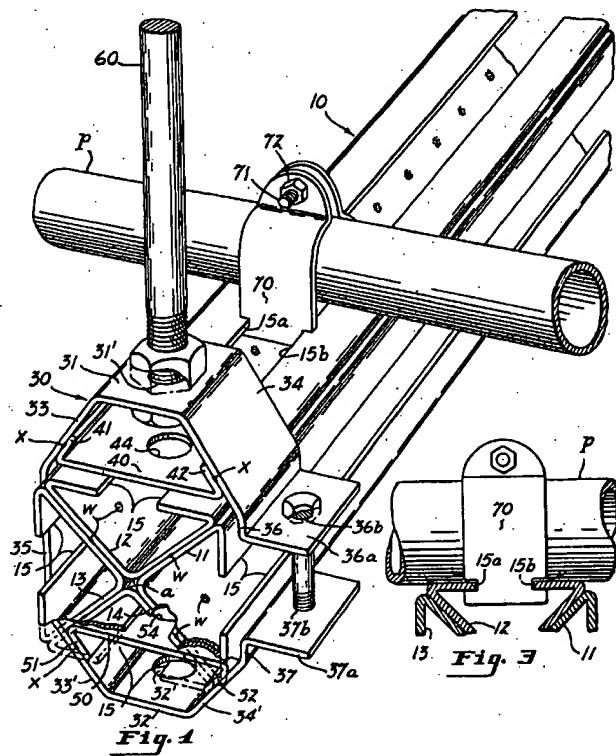
In rejecting Claims 38 and 39, the Examiner stated:

said coupling member (30) adapted to receive and support a conduit, the coupling member comprising a tubular member having at least one end, the end adapted to receive one end of the conduit, and the tubular member having a wall containing an aperture (31', 32' and internal nut); and

said connecting member (60) having opposite ends, one end of the connecting member securely engaging the aperture in the wall of the tubular member, the opposite end of the connecting member extending outwardly beyond the wall and adapted to securely engage a remote supporting structure, to securely hold and support the coupling member and the conduit in a selected position.

February 26, 2007, Office Action, p.3. Applicant believes the Examiner improperly rejected Claim 39 on the basis listed above because the scope of Claim 39 differs from Claim 38 and cannot be summarily rejected as if it is Claim 38.

As illustrated by the drawings below excerpted from the Sullivan reference, it is clear that the Examiner's reliance on the Sullivan reference as disclosing all the elements of Claims 38 and 39 is misplaced:



1. While the coupling member of the present invention requires it to be “a tubular member,” element 30 is clearly a polygonal C shape and not tubular.
2. The coupling member of the present invention requires it to “receives one end of said conduit along the longitudinal axis of the tubular member,” and element 30 only receives a triangular shape channel support 10 and not a tubular conduit as in the present invention.
3. The Examiner relied on the elements “31’, 32’ and internal nut” as the “aperture” of the present invention, the location of such aperture as shown in the Sullivan reference (i.e. on the wall of a polygonal C shape element 30) does not meet the claimed invention of having such an aperture “on the tubular member’s wall.”
4. Element 60 is required “to engage the aperture in the wall of the tubular member,” which cannot be met with the Sullivan’s aperture (31’, 32’ and internal nut) on the wall of a polygonal C shape element 30.
5. The Examiner completely failed to point to any element in the Sullivan reference that shows “one end of the connecting member securely engaging the aperture in the wall of the tubular member such that the end of the connecting member extends into the interior space to securely engage the ends of the conduits received in the coupling member.” Claim 39. As shown in the above figure, element 60 does NOT engage the ends of the conduits received in element 30; element 60 merely engages element 30 itself, and NOT the conduits received in element 30.
6. Element 30 is a structural support member for beams 10, which in turn support conduit P remote from element 30 and transversely to the axis of element 30. This is a different structure for a different purpose and cannot teach Applicant’s structure.

As discussed above, the Examiner improperly relied on the Sullivan reference in rejecting Claims 38 and 39 and all claims dependent therefrom. Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added) (A claim is anticipated under 35 U.S.C. §102(b) only if “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.W.2d 1913, 1920 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the ... claim”).

In particular, the Sullivan reference fails to disclose, at least, the elements shown in **bold** and *italics* below:

38. A combination of a coupling member, an electrical wire-carrying conduit having opposite ends, and a connecting member for positioning and securing said conduit to a remote supporting structure, wherein:

 said coupling member receives and supports said conduit, *said coupling member comprising a tubular member having a longitudinal axis and at least one end, said end receives one end of said conduit along said longitudinal axis, and said tubular member having a wall containing an aperture* facing said remote supporting structure; and

 said connecting member having opposite ends, *one end of said connecting member securely engaging said aperture in said wall of said tubular member*, the opposite end of said connecting member extending outwardly beyond said wall and adapted to securely engage said remote supporting structure, to securely hold and support said coupling member and said conduit in a selected position.

39. A combination of a coupling member, a pair of electrical wire-carrying conduit, each conduit having opposite ends, and a connecting member for positioning and securing a said pair of conduits to a remote supporting structure, wherein:

 said coupling member receives and supports said conduits, *said coupling member comprising an integral tubular member having a longitudinal axis and a generally cylindrical wall surrounding an interior space and opposed axially aligned ends, each of said ends receives one end of one of said pair of conduits along said longitudinal axis, and said tubular member having an aperture through said cylindrical wall into said interior space* facing said remote supporting structure; and

 said connecting member having opposite ends, *one end of said connecting member securely engaging said aperture in said wall of said tubular member such that said end of said connecting member extends into said interior space to securely engage said ends of said conduits received in said coupling member*, the opposite end of said connecting member extending outwardly beyond said wall and adapted to securely engage said remote supporting structure, to securely hold and support said coupling member and said pair of conduits in a selected position.

Therefore, the Sullivan reference fails to teach “each and every element” of Claims 38 and 39 and all claims dependent therefrom, as required under a §102(b) rejection. Hence, Claims 2-16, 18-35, and 37-40 are not anticipated by the Sullivan reference.

Similarly, the following rejections by the Examiner are also erroneous:

“In regards to claims 2 and 18, Sullivan discloses the wall being raised relative to the exterior surface of the tubular member.” February 26, 2007, Office Action, p.3. Implicit in

Claim 2, the coupling member of the present invention has two levels - an exterior surface and a raised surface. The Sullivan reference discloses only one uniformly flat surface.

“In regards to claims 9-16 and 25-32, Sullivan discloses a stop member (40) projecting internally at about the middle of the tubular member.” February 26, 2007, Office Action, p.4. As discussed above, the Examiner improperly relied on element 30 as the tubular member of the present invention. Element 40 is an element distinct from element 30. Therefore, as interpreted by the Examiner, element 40 cannot be the stop member of the present invention that has a round shape and projecting internally of the tubular member.

“In regards to claim 33, Sullivan discloses the end of the connecting member being positioned within the confine of the tubular member in contact with the one conduit (indirectly).” February 26, 2007, Office Action, p.4. As admitted by the Examiner, the connecting member does not contact the conduit directly. Claim 33 is now amended to require direct contact, which is not shown in the Sullivan reference.

“In regards to claim 34, Sullivan discloses each of the ends of the tubular member being externally threaded.” February 26, 2007, Office Action, p.4. As discussed above, the Examiner improperly relied on the polygonal C shape element 30 as the tubular member of the present invention, and as shown in the drawings, element 30 does not have ends that are externally threaded to receive the conduit. The ends where element 30 arguably receive the “conduit” are not externally threaded.

“In regards to claim 35, Sullivan discloses each of the ends of the tubular member further having an opening through the tubular member, the opening is internally threaded to receive a set screw for securely positioning the conduit.” February 26, 2007, Office Action, p.4. The Examiner did not point to any reference number(s) in the Sullivan reference as disclosing the

“further opening” nor the “set screw” of Claim 35. The Sullivan reference does not disclose these elements to anticipate this claim.

“In regards to claim 40, Sullivan discloses the tubular member further having a wall surrounding an interior space, wherein the aperture is adapted to receive the end of the connecting member within the interior space.” February 26, 2007, Office Action, p.4. The Examiner did not point to any reference number(s) in the Sullivan reference as disclosing the “further wall surrounding an interior space” of Claim 40. The Sullivan reference does not disclose these elements to anticipate this claim.

III. Conclusion

By virtue of the Applicant’s amendment to the claims and remarks thereto, all outstanding grounds of rejection and objection have been addressed and dealt with and, based thereon, it is believed that the application is now in condition for allowance and such action is respectfully solicited.

Respectfully submitted,


Howard C. Miskin
Attorney for Applicant
Reg. No. 18,999
STOLL, MISKIN & BADIE
350 Fifth Avenue, Suite 4710
New York, NY 10118
(212) 268-0900